UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/841,388	04/24/2001	Asif Adatia	11252-005	6352

7590 12/16/2004	**EXAMINER**
Steven J. Gelman	WASYLCHAK, STEVEN R
Klehr, Harrison, Harvey, Branzburg, & Ellers	

ART UNIT	PAPER NUMBER
3624	

| 260 South Broad Street |
| Philadelphia, PA 19102 |

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Office Action Summary	Application No.	Applicant(s)
		09/841,388	ADATIA, ASIF
		Examiner	Art Unit
		Steven R. Wasylchak	3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 July 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-23</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-23</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

    a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)	4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	6) ☐ Other: .

DETAILED ACTION

1.   **This action is in response to Applicant's supplemental response dated July**

29, 2004.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-5, 7-10,12-20, 22, 23 are rejected under 35 U.S.C. 102(b) as being

anticipated by Kennedy et al. (US 6,055,519).

Claims:

1.   An automated securities order execution system, comprising:

-order entering means for a client to enter an order;/ col 1, L 14-21, fig 2(32): request as

an order

-at least one filtering means for determining whether the order can be automatically

executed;/ col 1, L 14-21: securities, price filter

-routing means for routing the order to a destination based upon the determination

made by each of said at least one filtering means;/ col 2, L 54 to col 3, L 13 (NASDAQ

automatic execution)

-executing means for executing the order; and/ col 2, L 54 to col 3, L 13(Nasdaq

automatic execution)

-reporting means for reporting the result of the order execution to the

client./ col 2, L 54 to col 3, L 13(consequence of Nasdaq automatic execution)

2.   An automated securities order execution system according to Claim 1, wherein

said at least one filtering means includes

-first filtering means for determining whether the order contains sufficient information to

be executed./ col 2, L 54 to col 3, L 13; col 6, L 20-59

3.   An automated securities order execution system according to Claim 2, wherein

said at least one filtering means further includes

-second filtering means for determining whether the order can be automatically

executed./ col 2, L 54 to col 3, L 13; col 6, L 20-59

4.   An automated securities order execution system according to Claim 3, wherein

said at least one filtering means further includes

-third filtering means for determining whether an order to be automatically executed

meets the criteria of the market on which the security is traded./ col 2, L 54 to col 3, L

13; col 6, L 20-59

5.   An automated securities order execution system according to Claim 3, wherein

said second filtering means includes at least one filter to be applied to the order, each of

said at least one filter including a plurality of criteria that can be set by a user of the

system./ col 2, L 54 to col 3, L 13; col 6, L 20-59

7.   An automated securities order execution system according to Claim 1, wherein

said executing means sends the order to an exchange to be automatically executed./

col 2, L 54 to col 3, L 13(Nasdaq automatic execution)

8.   An automated securities order execution system according to Claim 1, wherein

said executing means fills the order from inventory./ col 1, L 34-38; col 13, L 22-31

9.   A method for automatically executing a securities trade, comprising the steps of:

-creating at least one filter;/ col 1, L 14-21: securities, price filter

-entering an order for a security by a client;/ col 1, L 14-21, fig 2(32):request as an order

-applying each of said at least one filter to the order to determine whether the order can

be automatically executed;/ col 2, L 54 to col 3, L 13(Nasdaq automatic execution) ; col

6, L 20-59

-routing the order to a destination based upon whether the order can be automatically

executed;/ col 2, L 54 to col 3, L 13(Nasdaq automatic execution)

-executing the order; and/ col 2, L 54 to col 3, L 13(Nasdaq automatic execution)

-reporting the results of the trade to the client./ col 2, L 54 to col 3, L 13(consequence

of Nasdaq automatic execution)

10.   The method of Claim 9, wherein the creating step includes defining a plurality of

criteria for each filter./ col 2, L 43-63

12.   The method of Claim 9, wherein the executing step includes sending the order to

an exchange to be automatically executed./ col 2, L 54 to col 3, L 13(Nasdaq automatic

execution)

13.   The method of Claim 9, wherein the executing step includes filling the order from

inventory./ col 1, L 34-38; col   13, L 22-31

14. (New): **An automated securities order execution system, comprising:**

order entering means for a client to enter an order;/ col 1, L 14-21, fig 2(32): request

as an order at least one broker filter for determining whether the

order can be processed;/ col 1, L 14-21: securities, price filter

  at least one trader filter for determining whether the order can be automatically

executed;/ col 1, L 14-21: securities, price filter

at least one compliance filter for determining whether the order meets the criteria of

the market on which the security is traded;/ col 2, L 54 to col 3, L 13; col 6, L 20-59

routing means for routing the order to a destination based upon the determination

made by said broker, trader and compliance filters;/ col 2, L 54 to col 3, L 13

(NASDAQ automatic execution)

executing means for executing the order; and/ col 2, L 54 to col 3, L 13(NASDAQ

automatic execution)

reporting means for reporting the result, of the order execution to the client./ col 2, L

54 to col 3, L 13(consequence of NASDAQ automatic execution)

15. (New): An automated securities order execution system according to Claim 14,

wherein each said at least one trader filter includes a plurality of criteria that can be

set by a user of the system./ col 2, L 54 to col 3, L 13; col 6, L 20-59

16. (New): An automated securities order execution system according to Claim 14, wherein, if the order cannot be automatically executed, said routing means sends the order to a trader for manual execution./ col 2, L 54 to col 3, L 13; col 6, L 20-59

17. (New): An automated securities order execution system according to Claim 14, wherein said executing means sends the order to an exchange to be automatically executed./ col 2, L 54 to col 3, L 13(NASDAQ automatic execution)

18. (New): An automated securities order execution system according to Claim 14, wherein said executing means fills the order from inventory./ col 1, L 34-38; col 13, L 22-31

19. (New): A method for automatically executing a securities trade, comprising the steps of:

creating at least one broker filter for determining whether the order can be processed;

creating at least one trader filter for determining whether the order can be automatically executed;

creating at least one compliance filter for determining whether the order meets the criteria of the market on which the security is traded;

entering an order for a security by a client;/all the above refer to claim 14

applying each of said at least one broker, trader and compliance filter to the order to determine   whether the order can be automatically executed;

routing the order to a destination based upon whether the order can be automatically executed;

executing the order; and

reporting the results of the trade to the client./all the above refer to claim 1

20. (New): The method of Claim 19, wherein

-the creating step includes defining a plurality of criteria for each of said at least

one broker, trader and compliance filter./refer to claim 14

22.   (New) : The method of Claim 19, wherein the executing step includes sending

the order to an exchange to be automatically executed./refer to claim 7

23.   (New) : The method of Claim 19, wherein the executing step includes filling

the order from inventory./refer to claim 8

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 6, 11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Kennedy et al. (US 6,055,519) and official notice.

Claims:

6.   Kennedy does not explicitly disclose an automated securities order execution

system if the order cannot be automatically executed, said routing means sends the

order to a trader for manual execution. Official notice is taken that this feature where an

automated securities order execution system if the order cannot be automatically

executed, said routing means sends the order to a trader for manual execution is old

and well known in the retail art. It would have been obvious to one of ordinary skill

in the art at the time of applicant's invention to implement this feature where the an

automated securities order execution system if the order cannot be automatically

executed, said routing means sends the order to a trader for manual execution.

advantage of consummating the sale and thus profit on the transaction with a "backup"

execution should the automated one fail.

11.   Kennedy does not explicitly disclose if the order cannot be automatically

executed, the routing step includes sending the order to a trader for manual execution.

Official notice is taken that this feature where if the order cannot be automatically

executed, the routing step includes sending the order to a trader for manual execution is

old and well known in the retail art. It would have been obvious to one of ordinary skill

in the art at the time of applicant's invention to implement this feature where if the order

cannot be automatically executed, the routing step includes sending the order to a

trader for manual execution for the advantage of consummating the sale and thus profit

on the transaction with a "backup" execution should the automated one fail.

21. (New): The method of Claim 19, wherein if the order cannot be automatically

executed, the routing step includes sending the order to a trader for manual

execution./refer to claim 6

Examiner responds to remarks:

Page 4: goods are securities as in commodity trading of pork bellies on the Chicago

Mercantile Exchange.

The client is further involved by taking delivery of the stock and receiving monthly

account balances or canceling the transaction before execution or being subject to a

margin call.

Page 5: a package is buying into a mutual fund traded on the exchange that is

packaged with groups of stocks; this is mere centralization which is not novel absent

a new use that does appear to exist in the given claims.

Pages 6, 7: NASDAQ per se speaks volumes on the computerized execution of

orders. NASDAQ is regulated by the SEC and FRB regulation T establishing margin

requirements and has contact with brokers such as Merrill Lynch or Ameritrade for

accepting orders to trade on NASDAQ or the NYSE. One stock exchange, such as

the New York Stock Exchange, while computerized under Grasso, previously had

market specialists as traders who traded in their own accounts of stock inventory to

accommodate odd lot trading and to keep the trading process smoothly running during volatile trading periods. Examiner has visited the New York and Montreal stock exchanges and can attest to their trading operations first hand. Applicant is aware that to automate that which was done manually is not novel absent a new use, which the examiner respectfully finds to be lacking in the present case.

Applicant's representative is invited to contact the examiner to discuss the future prosecution of this application.

This action is **FINAL**. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven R. Wasylchak whose telephone number is (703) 308-2848.   The examiner can normally be reached on Monday-Thursday from 7:00 a.m. to 6:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1065. The fax number for Art Unit 3624 is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Steven Wasylchak   12/11/04
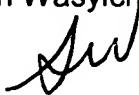
VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600